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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,490	01/07/2002	Gavriel Meron	P-2038-US1	4535
27130	7590	08/05/2004	EXAMINER	
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020			PADMANABHAN, KARTIC	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/036,490

**Applicant(s)**

MERON ET AL.

**Examiner**

Kartic Padmanabhan

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-16 and 18-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-16,18-22,45,46,49 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5,7-16 and 18-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 4/28/04 is acknowledged.
2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4, 7-8, 14-16, 18-22, and 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Kovacs et al. (US Pat. 5,833,603). The reference discloses an implantable biosensing transponder comprising a biosensor which may sense optical, mechanical, or chemical properties. The device also includes a transponder for wirelessly transmitting data corresponding to the sensed parameter to a remote reader. Disclosed embodiments use chemical sensors and pressure sensors (abstract). Nearly any type sensor can be used with the transponder of the reference, and the transponder can be used to measure a variety of parameters, including blood chemistry, such as sugar and hemoglobin levels (Col. 3). The biosensor may be completely positioned within a capsule (Col. 4). In one embodiment, the transponder includes

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photosensors for optically detecting physical properties at the implant site. The biosensor may comprise an array of photosensors, such as an imager, for providing an image of the implant site. Biosensing transponders using photosensors can also include one or more optical emitters for illuminating the implant site with specific wavelengths of light. For example, chemical sensitive dyes may be illuminated to detect a change in an optical property of the dye to detect a physical property of the external environment (Col. 5). An example of a biosensing transponder that uses a dye-based chemical sensor has a dye positioned on an exterior portion of the capsule, thereby exposing the dye to the external environment. The capsule may be implanted in contact with tissue or blood. Another dye of the same type of dye as is located on the exterior of the capsule is located within the capsule. The capsule is constructed from transparent glass. An optical emitter illuminates the dyes and causes them to emit fluorescence, and photosensors detect the optical properties of the dyes upon illumination. Dye on the outside of the capsule interacts with the environment to produce an optical change, which can be compared to dye within the capsule (Col. 10). Photosensors can also be used for direct optical sensing of the environment, such as for determining color of an organ (Col. 11).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3, 5, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kovacs et al. (US Pat. 5,833,603) in view of Desai et al. (US Pat. 5,362,478).

Kovacs et al. teach a biosensing transponder, as previously discussed. However, the reference does not teach a swallowable capsule or a plastic support.

Desai et al. teach magnetic resonance imaging with fluorocarbons encapsulated within a polymeric shell. A suspension of polymeric shells can be administered intravenously or orally, and can facilitate optical imaging of the organ to which they are directed. The capsules of the reference can be used to obtain local oxygen or temperature data. Magnetic resonance imaging is used to illuminate the polymeric shells, and allows the determination of the location of the shells, as well as the parameter of interest.

It would have *been prima facie* obvious to one of ordinary skill in the art at the time of the invention to use a swallowable capsule as taught by Desai et al. for encapsulating the biosensing transponder of Kovacs et al. because Desai et al. teach the use of a swallowable

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capsule directed to a particular location for imaging and Kovacs teach that their transponder may be completely packaged within a capsule. Kovacs et al. also teach that any sensor can be used and is only limited by the size of the sensor and space at the location. As such, one would have a reasonable expectation of success in using a sensor of dimensions appropriate to fit within a swallowable capsule while still achieving the results of the Kovacs transponder. It would have also been obvious to use plastic as the support material with the device of Kovacs and Desai because any transparent material would have worked with the optical sensor of Kovacs. In addition, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kovacs et al. (US Pat. 5,833,603) in view of Atarashi et al. (US Pat. 6,162,469).

Kovacs et al. teach a biosensing transponder, as previously discussed. However, the reference does not teach a biological reactant.

Atarashi et al. teach a medical powder which comprises polymeric microspheres having thereon immobilized antigen or antibody for detection or diagnosis purposes. The powder may be used in vivo.

It would have been *prima facie* obvious to one of ordinary skill in the art to use a biological compound as the reactant as in Atarashi et al. on the support of Kovacs et al. because Atarashi et al. teach that biological compounds bound to supports may be used in vivo. Further, depending on the analyte of interest, one of skill in the art could have used its appropriate receptor with a reasonable expectation of success that it would function in a manner similar to the dye of Kovacs et al. In addition, it has been held to be within the general skill of a worker in

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the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

Claims 1-5, 7-16, 18-22, 45-46, and 49-50 are rejected.

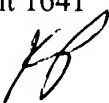
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 571-272-0825. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kartic Padmanabhan  
Patent Examiner  
Art Unit 1641

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07/25/04